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10/561,699

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EXAMINER

TRAN, THUAN Q

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/561,699 | Applicant(s) GRINBERG ET AL. | |
| | Examiner Thuan Tran | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6-18,20-35,37,41,45,46,48,50 and 52-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 6-18, 20-33, 34, 35, 37, 41, 45, 46, 48, 50, and 52-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-27-2009 and 12-15-2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-12-2009 has been entered.

Status of Claims

1. This action is in reply to the amendment filed on 11-12-2009.
2. Claims 2, 3, 6, 7, 10-13, 15-18, 20, 22-24, 27-29, 31, 32, 34, 35, 37, 41, 45, 46, 50, and 52 have been amended.
3. Claims 1, 4, 19, 33, 36, 38-40, 42-44, 47, 49, and 51 are cancelled.
4. Claims 53-64 are new.
5. Claims 2, 3, 6-18, 20-33, 34, 35, 37, 41, 45, 46, 48, 50, and 52-64 are currently pending and have been examined.

Information Disclosure Statement

6. The Information Disclosure Statements filed on 7-27-2009 and 12-15-2009 have been considered. An initialed copy of the Form 1449 is enclosed herewith.

Response to Arguments

7. Applicant's arguments, filed 11-12-2009, with respect to the rejections under 35 USC 101 have been fully considered and are persuasive. The rejections under 35 USC 101 have been withdrawn.
8. Applicant's arguments with respect to rejections under 35 USC 102 and 103 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2, 3, 6-18, 20-33, 34, 35, 37, 41, 45, 46, 48, 50, and 52-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 53 and 60 state in part, "to facilitate the customer computing device providing a security device via the connection, to the financial institution application to enable the financial institution computing device to process payment from the customer account to the merchant account." It is unclear how the interface means facilitates providing a security device. For the purpose of this examination, the examiner understands that the interface means provides the security device via the connection.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 2, 3, 6-12, 15-18, 20-28, 31-33, 34, 35, 45, 46, 48, 50, and 52-64** are rejected under 35 U.S.C. 102(a) as being anticipated by Langer et al., US Patent 7,634,445.

13. **As per claims 53, 60, 63, and 64:**

Langer teaches:

- a transaction facilitating computing device including a processor, memory and software arranged to generate a payment gateway accessible by the customer computing device at a merchant network site generated by the merchant computing device (see at least column 2 line 14-44),

Examiner notes: When the WAP user reviews the shopping cart, column 2 line 37-39, the shopping cart is on the merchant's server at the merchant's network, column 2 line 16-20. The WAP user may then review the information in the shopping art and decide to purchase the items. At this point payment information is sent to the payment gateway. Thus, the payment gateway is accessible at the at the merchant network site.

Art Unit: 3693

- the payment gateway arranged to initiate a payment process for the customer computing device to control payment to a merchant account from a customer account via a financial institution computing device (see at least column 2 line 45-60), and
- an interface means arranged to control the customer computing device to connect the customer computing device to a financial institution application provided by the financial institution computing device (see at least column 2 line 14-60), to facilitate the customer computing device providing a security device via the connection, to the financial institution application to enable the financial institution computing device to process payment from the customer account to the merchant account (see at least column 2 line 45-60), without the security device being transmitted via the merchant network site and merchant computer (see at least column 1 line 35-37, column 2 line 53-60, and column 3 line 1-3).

Examiner notes: The security device is the payment confirmation which executes the funds transfer from the WAP user to the merchant.

Examiner further notes: Because of the use of the phrase “to enable” in the claim language, the following claim language is considered intended use, thus, is given not patentable weight: “to enable the financial institution computing device to process payment from the customer account to the merchant account, without the security device being transmitted via the merchant network site and merchant computer.”

However, in an attempt to further prosecution of this application, the examiner has pointed out sections of Langer that teaches this intended use.

14. **As per claims 2 and 20** Langer further teaches:

- wherein the interface means is arranged to connect the customer computing device to the financial institution application in real-time to enable the payment to proceed in real time (see at least column 2 line 45-60).

15. **As per claims 3 and 21** Langer further teaches:

- wherein the interface means is arranged to connect the customer computing device to the financial institution application during the on-line product transaction to enable the payment to occur during the product transaction (see at least column 2 line 45-60).

Examiner further notes: Because of the use of the phrase “to enable” in the claim language, the following claim language is considered intended use, thus, is given not patentable weight: “to enable the payment to occur during the product transaction.”

16. **As per claims 5 and 22** Langer further teaches:

- wherein the interface means is arranged to generate confirmation to the merchant computing device that payment has occurred, the interface means connecting the financial institution computing device to the merchant computing device to enable confirmation. (see at least page column 2 line 52-53).

17. **As per claims 6 and 23** Langer further teaches:

Art Unit: 3693

- wherein the interface means is arranged to provide a secure connection between the financial institution computing device and the merchant computing device for generation of confirmation that payment has occurred (see at least column 1 line 34-36 and column 2 line 53-60).

18. **As per claims 7 and 24** Langer further teaches:

- the interface means being arranged to obtain transaction details from the merchant network site and provide the transaction details to the financial institution application to facilitate payment (see at least column 2 line 37-60).

19. **As per claims 8 and 25** Langer further teaches:

- wherein the transaction details include the payment amount (see at least column 2 line 27-35).

20. **As per claims 9 and 26** Langer further teaches:

- wherein the transaction details include a merchant account identifier (see at least column 2 line 31, dealer ID).

21. **As per claims 10** Langer further teaches:

- wherein the financial institution application is a known pre-existing financial institution application (see at least column 2 line 55-57).

Art Unit: 3693

22. **As per claims 11 and 27** Langer further teaches:

- wherein the security device is provided by the customer entering the security device via the customer computing system (see at least column 2 line 42-44, the PIN).

23. **As per claims 12 and 28** Langer further teaches:

- wherein the security device is stored in a storage location accessible via the customer computing device, and the interface means is arranged to obtain the security device from the storage location via the customer computing device (see at least column 1 line 58-60, the MSISDN).

24. **As per claims 15 and 31** Langer further teaches:

- further including a database arranged to store transaction details of transactions (see at least column 2 line 45-60).

25. **As per claims 16** Langer further teaches:

- wherein the database is arranged to be accessible by the merchant computing device to enable a merchant to obtain details of transactions that they are associated with (see at least column 2 line 16-20).

26. **As per claims 17** Langer further teaches:

Art Unit: 3693

- wherein the database is arranged to be accessible by customer computing devices to enable customers to obtain details of transactions that they are associated with (see at least column 2 line 19-20).

27. **As per claims 18 and 32** Langer further teaches:

- wherein the interface means is an agent application (see at least column 2 line 53-56).

28. **As per claims 34, 35, and 45** Langer further teaches:

- An operating system that has a computer readable medium that provides a computer program instructions to a computer to perform the method steps described (see at least column 1 line 50 to column 2 line 11).

29. **As per claims 46, 48, 50 and 52** Langer further teaches:

- wherein the financial institution application is an internet banking application (see at least column 2 line 45-60, the bank network)
- wherein the connection is implemented to connect the financial institution application to the customer computing system (see at least column 2 line 45-60).

30. **As per claim 54** Langer further teaches:

Art Unit: 3693

- wherein the interface means is arranged to automatically navigate the financial institution application to enter the transaction details (see at least column 2 line 53-60).

31. **As per claim 55** Langer further teaches:

- wherein the interface means is arranged to automatically navigate the merchant network site and obtain data from the merchant network site to obtain the transaction details (see at least column 2 line 27-60).

32. **As per claim 56** Langer further teaches:

- wherein the interface means is arranged to store the transaction details in the database (see at least column 2 line 27-44).

33. **As per claim 57** Langer further teaches:

- wherein the transaction facilitating computing device is arranged to download the agent application (the transaction details) on initiation of the payment process (see at least column 2 line 27-44).

34. **As per claim 58** Langer further teaches:

- the system further comprising the financial institution application and financial institution computing device (see at least column 2 line 55-60).

Art Unit: 3693

35. **As per claim 59** Langer further teaches:

- further comprising the customer computing device (see at least column 50-52).

Claim Rejections - 35 USC § 103

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. **Claims 13, 14, 29, 30, 37, and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Langer et al., US Patent 7,634,445.

38. **As per claims 13 and 29:**

Langer teaches claims 36 and 40. He does not teach encrypting and decrypting a security device. However, the examiner takes **Official Notice** that it is old and well known in the finance arts wherein the security device is stored in encrypted form, and wherein the interface means is arranged to decrypt the encrypted security means. It would have been obvious to one of ordinary skill in the art at the time of the invention to use encryption with the storage device to add an extra layer of security to the transaction.

39. **As per claims 14 and 30:**

Art Unit: 3693

Langer teaches claims 36 and 40. He does not teach encrypting and decrypting a security device. However, the examiner takes **Official Notice** that it is old and well known in the finance arts for the system including storage means for storing decryption keys for decrypting encrypted security means. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a storage means for the decryption keys with motivation to provide a easier way to record and enter when needed the often lengthy and complicated decryption key. This is easier and faster than a user manually entering the decryption key each time decryption occurs.

40. As per claims 37 and 41:

Langer teaches claims 36 and 40. He does not teach that the communications are in the form of e-mails. However, the examiner takes **Official Notice** that it is old and well known in the finance arts to make communications in the form of e-mail messages. It would have been obvious to one of ordinary skill in the art at the time of the invention to communicate through e-mail messages to quickly communicate between parties.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Tran whose telephone number is 571-270-1832. The examiner can normally be reached on Monday-Friday 8:30-5:00.

Art Unit: 3693

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thuan Tran
Patent Examiner
1-27-2010

/Stefanos Karmis/
Primary Examiner, Art Unit 3693